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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,697	09/15/2003	William J. Boyle	ACS 65470 (2309D)	9777

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EXAMINER

WEBB, SARAH K

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 03/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

811

# Office Action Summary

Application No.

10/662,697

Applicant(s)

BOYLE ET AL.

Examiner

Sarah K Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 35-67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 35-67 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

**DETAILED ACTION*****Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 35-40, 42-50, and 52-67 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6,171,327 to Daniel et al.

Daniels illustrates a catheter system in Figures 20-23 that is designed for recovery of an embolic filter (21) that is disposed on a guide wire (26). The retrieval device includes an inner catheter (172 in Figure 20 or 372 in Figure 23) that extends distally beyond a recovery sheath (151). The recovery sheath (151) tracks over the distal portion of the inner catheter to retrieve the filter, as shown in Figure 19. The inner catheter can be constructed to have either greater or less column strength than the recovery sheath, as evidenced by the various configurations of Figures 20 and 23. As evidenced by the fact that the recovery sheath (151) is capable of deforming the distal end (180, 280) of the inner catheter when pushed distally to retrieve the filter, the distal portion of the inner catheter is more flexible than the recovery sheath (151). Daniels also explains that the distal portion of the inner catheter is made of flexible material (column 8, lines 61-67). Each catheter has a control handle attached to its proximal end, and the handles are illustrated in Figures 24-26. Control handle 702 is connected to the proximal end of the recovery sheath (151) and control handle 710 is connected to the proximal end of the inner catheter (372).

Inner catheter (372) can be locked onto the guide wire (26) by way of a threaded connection between the handle (710) and a locking mechanism that includes a guide wire clamp (720) and a collet (718). The recovery sheath control handle (702) is locked

with the inner catheter control handle (710) by a stop (708) that prevents the handles (702,710) from becoming separated but allows the handles to slide relative to one another.

Regarding claims 36,46,56, and 57, the language “may be up to”, “may be up to approximately”, and “may extend up to” is significantly broad to include any length less than the stated dimension. Therefore, the Daniel device meets this limitation, since the recovery sheath is clearly shorter than the inner catheter.

Daniel discloses steps of using the device in column 10 that include advancing the inner catheter and recovery sheath over a guide wire, locking the inner catheter to the guide wire, advancing the recovery sheath over the filter to collapse it, and removing the entire system from the patient's body.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 41 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniel in view of US Patent No. 5,201,757 to Heyn et al.

Daniel includes all the limitations of claims 41 and 51, except that the position of the handles is switched so that control handle of the recovery sheath is coaxially disposed within the lumen of the control handle of the inner catheter. Heyn discloses a device with control handles for sheaths that move relative to one another. Heyn teaches that the control handle (60) for the inner catheter (44) can be disposed within the control handle (56) of the outer sheath (20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to simply rearrange the control handles of Daniel so that the control handle of the inner catheter is disposed

within the lumen of the recovery sheath handle, as Heyn teaches that this is an alternate way to configure control handles of relatively moving sheaths.

### ***Response to Arguments***

3. Applicant's arguments filed 12/2/704 have been fully considered but they are not persuasive. Applicant argues that the distal portion of the inner catheter in Figures 20-23 of the Daniels patent does not meet the limitation "*length of flexible tubing*" because it is bulky, short, and tapered. The distal portion (172,180) is part of the inner catheter, which is a flexible tube. Daniels explains that the entire inner catheter, including the distal tapered portion (180), is formed of flexible materials (column 8, lines 61-67). The distal portion has a length. Therefore, the distal portion, regardless of its tapered structure, meets the broad limitation "*length of flexible tubing.*"

For clarification, claims 55-57 are rejected by Daniels under 102(e). The exclusion of these claims from the 102 (e) section of the previous office action was a typographical error, but the claims were listed as rejected on the Office Action Summary sheet. For further evidence to this, the examiner had made statements regarding the rejection of claims 55,56, and 57: "Regarding claims 36,46,56, and 57..." and "...removing the entire system from the patient's body."

### ***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarah K Webb whose telephone number is (571) 272-4706. The examiner can normally be reached on Mon-Fri 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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3/4/05

SKW

*Julian W. Woo*

JULIAN W. WOO  
PRIMARY EXAMINER